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09/237,125 01/26/99 PADMANABAN

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EXAMINER

IM52/0718

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| ASHTON, R | |
| ART UNIT | PAPER NUMBER |

1752
DATE MAILED:

07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/237,125

Applicant(s)

Padmanaban et al.

Examiner

Rosemary Ashton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 25, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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Upon review of applicant's invention the examiner finds the claim language necessitates an undue burden for searching the plethora of polymers claimed. For example, Applicant defines the copolymer in claim by using five monomer units defined by m,n,o,p,q but defines n,p,q as integers including 0 and m and o as integers including 0 while at least one of them is greater than 0. Thus, the polymers include numerous polymers because the claim includes homopolymer of units m and o, as well as every possible 2,3,4 and 5 copolymer combination comprising monomer units n,p,q and m and/or o. This burdensome search occurs in all applicant's claims thus the examiner has limited the claims by an election of species requirement.

For examination purposes, upon election of Group I, the examiner requests applicant to elect a single copolymer from either claim 2, claim 3 or claim 30 for examination of Group I wherein the copolymer includes the maximum number of monomer units.

For examination purposes, upon election of Group II, the examiner requests applicant to elect a single copolymer from claim 1 wherein the copolymer includes the maximum number of monomer units. The elected polymer will be examined for claim 17.

For examination purposes, upon election of Group IV, the examiner requests applicant to elect a single copolymer from claim 15 wherein the copolymer includes the maximum number of monomer units. The elected polymer will be examined for claim 21.

Additionally, Claim 14 includes two different invention by use of "and/or" language wherein a basic additive is added to the composition of claim 13 which includes the polymer of

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claim 1 and the monomer of claim 13 and which also includes a basic additive added to the monomer of claim 13. These inventions are restrictable as stated below.

Claim 16 reads on the polymer of claim 1, the compound of claim 13 and the polymer of claim 15 having an specific amount of monomer units and will be examined with, and limited to, its elected invention.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12,16,22-24,25,26,30,31 are drawn to an radiation absorbing composition, classified in class 430, subclass 270.1.
 - II. Claims 13,14,16-20,25,28 are drawn to a radiation absorbing composition, classified in class 430, subclass 281.1 wherein claim 14 adds a basic additive to the monomer and polymer of claims 1 and 13.
 - III. Claim 14, drawn to a radiation absorbing composition, classified in class 430, subclass 281.1 wherein claim 14 adds an amine to the monomer of claim 13.
 - IV. Claims 15,16,21 are drawn to a radiation absorbing composition, classified in class 430, subclass 270.1.
 - V. Claim 27, drawn to a method of making an integrated circuit, classified in class 430, subclass 325.
 - VI. Claim 29, drawn to a method of making an integrated circuit, classified in class 430, subclass 325.

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~~VII. Claims 30,31, drawn to an radiation absorbing composition, classified in class 430, subclass 270.1.~~

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and either Group V or VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the radiation sensitive composition are useful in making a static resistant reticle.

3. Inventions Group I or IV and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the radiation absorbing composition of Groups I and IV do not have an unsaturated monomer as in Group II which is classified in 430/281.1 not 430/270.1.

4. Inventions Groups I,II or IV and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the radiation absorbing composition of Group III does not having a polymer as do Groups I,II and IV.

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5. Inventions Group I and Group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because claim 15 requires the polymer have the monomer r, either as a homo or copolymer. This monomer unit is not present in the copolymers of Group I and thus the polymer is patentably distinct from the other polymers.

6. Because these inventions are distinct for the reasons given above and the search required for Groups I is not required for any of Groups II, III, V or VI restriction for examination purposes as indicated is proper.

7. Because inventions Group I and Group IV are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Election

8. Claim 1 is generic to a plurality of disclosed patentably distinct species comprising the polymers having the formulas shown in claims 1, 2, 3, 5, 15 and 30. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Ashton whose telephone number is (703) 308-2057 or to Supervisory Examiner J. Baxter whose telephone number is (703) 308-2303.

July 14, 2001



Rosemary Ashton
Patent Examiner
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**ROSEMARY ASHTON
PRIMARY EXAMINER**